

### **REMARKS**

The Office Action mailed August 22, 2008 has been carefully considered.  
Reconsideration in view of the following remarks is respectfully requested.

#### **Rejection(s) Under 35 U.S.C. §§102 and 103 Based on Tøpholm**

Claims 1-2, 6-8 and 24-26 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Tøpholm (U.S. pat. no. 4,585,089). Applicants respectfully traverse.

Claims 1 and 24, from which the remaining claims variously directly or indirectly depend, have been amended to state, for example according to claim 1, that the rotatable cap has “a sound exit port configured to directly communicate sound from the speaker to an ear canal of a user when the earpiece is worn by the user” This is not the case in Tøpholm, in which the coupling element<sup>1</sup> depicted in FIG. 3 is designed to fit into earbud 29 (FIG. 4) and does not engage the ear canal.

Claims 1 and 24 also recite rotatability of the cap, without disassembly of the rotatable cap from the housing or without uncoupling said rotatably coupled cap, a feature also not disclosed in Tøpholm. This is particularly evident from Tøpholm’s recitation of “locking engagement”<sup>2</sup> between the housing and the coupling element. It is clear in Tøpholm that his coupling element only may be rotated to a desired orientation (“adapted to the user’s ear,” col. 2, ll. 29-30) before snapping it onto the nipple, but that after the coupling element is engaged with the nipple, it is in locking engagement and no longer rotatable unless first disassembled. The only discussion of rotation in Tøpholm which refers to rotation without disassembly relates to tube section 27, which, due to the friction fit of sleeve 28, can rotate about spout 23.<sup>3</sup>

It will be appreciated that, according to the M.P.E.P., a claim is anticipated under 35 U.S.C. §102 only if each and every claim element is found, either expressly or inherently

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<sup>1</sup> The labeling in Tøpholm is unclear, and for purposes of this discussion, the entire component shown in FIG. 3 will be referred to as the coupling element consistent with the use of that term in col. 2, l. 30 of Tøpholm.

<sup>2</sup> Tøpholm, col. 2, l. 40.

<sup>3</sup> *Id.*, col. 2, ll. 51-55.

described, in a single prior art reference.<sup>4</sup> The aforementioned reasons clearly indicate the contrary, and withdrawal of the 35 U.S.C. §102 rejection based on Tøpholm is respectfully urged.

Claims 3-5, 9, 13 and 30-31 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Tøpholm. Applicants respectfully traverse.

As mentioned above, the device of Tøpholm is designed to fit in an earbud. Such a design requires precise alignment of the coupling element with the portion of the earbud into which it is to be inserted. The dimensions involved would be known, and there would be no need to account for natural anatomic variations between ears of different users. Accordingly, there would be no need to provide rotatability, and such a feature would therefore not be obvious from Tøpholm.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>5</sup>

**Rejection(s) Under 35 U.S.C. §103(a) Based on Tøpholm in View of Uemura *et al.***

Claims 10-12 and 27-29 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Tøpholm in view of Uemura *et al.* (U.S. pat. no. 3,324,253). Applicants respectfully traverse.

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<sup>4</sup> Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>5</sup> M.P.E.P. § 2143.

Claims 10-12 and 27-29 variously depend, directly or indirectly, from the base claims addressed above. Uemura *et al.* fails to remedy the above-mentioned shortcomings of Tøpholm with respect to the base claims. Accordingly, claims 10-12 and 27-29, which by definition include all the limitations of the base claims, are patentable over the combination of these references.

### **Conclusion**

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

Please charge any additional required fees, including those necessary to obtain extensions of time to render timely the filing of the instant Amendment and/or Reply to Office Action, or credit any overpayment not otherwise credited, to our deposit account no. 50-3557.

Respectfully submitted,  
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